



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/335,742	06/18/1999	MARIE-PASCALE AUDOUSSET	05725.0429-0	6824

7590

10/15/2002

FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER LLP
1300 I STREET NW
WASHINGTON, DC 200053315

EXAMINER

EINSMANN, MARGARET V

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 10/15/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/335,742	Applicant(s) AUDOUSSET, MARIE-PASCALE	
	Examiner Margaret Einsmann	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's remarks filed 7/31/2002 have been fully considered. No claims have been amended in the response of 7/31/2002. Claims 1-56 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27, 30-34 and 37- 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henkel in view of Tsujino.

Henkel, WO 92/13824, teaches compounds of formula (1) as developer compounds for the production of oxidation hair colorants. Henkel's preferred developers of formula (1) include the claimed 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane first oxidation base and acid addition salts thereof (e.g. tetrahydrochloride) (see example 1.1) Henkel teaches that very brilliant and uniform hair colors may be obtained with good color fastness properties when the developers of formula (I) are mixed with suitable couplers. (Abstract) Henkel exemplifies various compositions which contain the claimed first oxidation base in combination with a coupler as claimed, e.g. 1-naphthol and m-aminophenol, wherein the oxidation bases and couplers are present in the claimed amounts, See examples 2.1-2.13. The compositions are

Art Unit: 1751

aqueous and may contain solvents and adjuvants as claimed in the claimed amounts. See page 4 line 29 to page 5 line 16 and example 2. Henkel teaches that the compositions may also contain other known primary intermediates in order to vary the nuances, as well as direct dyes as claimed. See page 4 lines 12-17. Henkel's exemplified compositions also contain ammonia as claimed, and the compositions may have pH's from 6-10 as claimed. See page 5 last paragraph and example 2. Henkel's teaching of acidic pH's suggests the addition of acidifying agents to the patentee's compositions. Henkel's exemplified compositions are mixed with a hydrogen peroxide oxidant, and are applied to the hair as claimed. Henkel's processes may use other oxidants as claimed (page 5 lines 22-28). Henkel does not teach second oxidation bases as specifically claimed. The patentee also does not appear to teach the specifically claimed uricase oxidants, oxidant pH's and additives, separate oxidant application step, and dyeing devices and kits.

Tsujino, U.S. patent 4,961,925 teaches the use of dielectron reducing oxidases, including the claimed uricase, as oxidants for dyeing keratin fibers. (col 1 lines 46-54, col 2 lines 37-40) Tsujino teaches that oxidases are an improvement over conventionally used hydrogen peroxide oxidants because they result in less damage to the skin and hair. (col 1 lines 11-43). Tsujino teaches that conventional oxidation dyes include second oxidation bases as currently claimed (e.g. para-phenylenediamine) as well as couplers as claimed (e.g. 2-methyl-5(2-hydroxyethylamino)-phenol. (col 2 line 45-col 3 line 3). Tsujino teaches that the dye and oxidant compositions may be separately packaged in kits/devices as claimed. (Col 2 lines 41-44 and examples 7-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a second oxidation base as claimed to Henkel's exemplified compositions in the claimed amounts, resulting in dyeing compositions as claimed, because Henkel teaches that any conventional oxidation bases may be added to the compositions in order to obtain the desired hair colors and nuances, and Tsujino teaches that the claimed second oxidation bases are conventional in the hair dyeing art, absent a showing otherwise. It would have been obvious to those skilled in the art to use a uricase oxidant as claimed in Henkel's processes because Tsujino teaches that the use of oxidase enzymes in place of Henkel's exemplified hydrogen peroxide results in decreased damage to both the skin and the hair. It would have been obvious to those skilled in the art to package Henkel's compositions in multi-compartment devices and kits as claimed because Henkel suggests such packages are conventional for the storage of two-part oxidative hair dyeing formulations.

The office holds the position that the claimed oxidant additives and separate application steps are patentably indistinct from Henkel's teachings as modified by Tsujino because the same end results are obtained, i.e. the application of a dye, oxidant and additives to the hair, absent a showing otherwise. Furthermore, the optimization of parameters such as oxidant pH would have been obvious to those skilled in the art in order to obtain the most effective dyeing results, absent a showing otherwise. See *In re Aller*, 105 USPQ 233; *In re Luck*, 177 USPQ 523, and *In re Bosech*, 205 USPQ 215.

Claims 1-7, 9-13, 15-38, 41-53 and 55-56 are rejected under 35 USC 103(a) as being unpatentable over Andrillon in view of Henkel.

Andrillon, US 4,065,255 teaches compositions for dyeing hair which contain at least one coupler of the formula exemplified and "at least one" oxidation base, See abstract. The patentee teaches that such compositions are highly resistant to washing, weather and light (Col 1 line 67-col 2 line 18). The oxidation bases and couplers may be present in the claimed amounts at the claimed pH's, wherein acids and bases as claimed may be used to adjust the pH. (Col 4 lines 9-16 and 45-52) Andrillon teaches that organic solvents, including ethanol, may be added to the compositions in the claimed amounts, as well as direct dyes and cosmetic adjuvants as claimed, including antioxidants, sequestering agents and basifying agents. (col 4 lines 17-50). The oxidant may comprise hydrogen peroxide or persulfates as claimed, and may be mixed with the dyeing composition before application or applied separately as claimed. (col 4 lines 40-43 and col 4 line 56 to col 5 line 16) . Particularly note example 4 wherein Andrillon exemplifies a composition which contains the second oxidation base p-phenylenediamine and the coupler 2-methyl-5-N-b-hydroxyethylamino phenol as claimed, which composition is mixed with hydrogen peroxide and applied to hair as claimed. Andrillon does not teach the 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane first oxidation base as claimed, or specifically teach the claimed oxidant additives and pH's, the specific additives of claims 28-29, or the claimed kits and devices.

Henkel is relied upon as set forth above as teaching that the claimed 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane first oxidation base is a preferred oxidation base for use in hair dyeing compositions which contain suitable couplers because very brilliant and uniform hair colors may be obtained with good color fastness properties. Note that

Art Unit: 1751

Henkel teaches that aminophenols are suitable couplers. See abstract> Henkel is also relied upon above as teaching that the patentee's oxidation bases and couplers may be combined with conventional oxidation bases.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the claimed 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane first oxidation base to Andrillon's compositions, such as the composition of example 4 wherein the compositions are applied to hair in combination with oxidants as claimed in dyeing processes as claimed, because Andrillon suggests that mixtures of oxidation bases may be used in the patentee's compositions and processes and Henkel teaches that this claimed oxidation base may be combined with Andrillon's m-aminophenol couplers and additional oxidation bases. Furthermore, Henkel specifically teaches that the claimed first oxidation base results in dyeings with good fastness properties, a result specifically desired by Andrillon, further motivating those skilled in the art to select Henkel's oxidation base for use in Andrillon's compositions and processes.

It would have been obvious to those skilled in the art to add claimed adjuvants to Andrillon's compositions as modified by Henkel because Andrillon teaches such additives as appropriate for the patentee's compositions (e.g. acids, solvents, etc). Furthermore, the office holds the position that the selection of conventionally used adjuvants such as antioxidants and sequestrants would have been obvious to those skilled in the art in order to obtain the most effective hair dyeing compositions. Andrillon's teaching of separate dye and oxidant compositions suggests their storage in conventional multi-part devices and kits as claimed.

The office holds the position that the claimed oxidant additives and separate application steps are patentably indistinct from Andrillon's teachings as modified by Henkel because the same end results are obtained, i.e. the application of a dye, oxidant and additives to the hair, absent a showing otherwise. Furthermore, the optimization of parameters such as oxidant pH would have been obvious to those skilled in the art in order to obtain the most effective dyeing results, absent a showing otherwise. See *In re Aller*, 105 USPQ 233; *In re Luck*, 177 USPQ 523, and *In re Bosech*, 205 USPQ 215.

Response to Arguments

Applicant's arguments filed 7/31/2002 have been fully considered but they are not persuasive regarding the rejection of the claims under 35 USC 103(a) as being unpatentable over Henkel in view of Tsujino. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art knows that it is conventional practice to use combinations of oxidation bases in oxidation hair dyeing compositions and process, and also the suggestion or motivation does indeed exist in Henkel at page 4 lines 12-17. Applicant further argues that the suggestion must be "clear and particular".

Art Unit: 1751

Henkel teaches clearly and particularly applicant's first oxidation base as being preferred, and also particularly teaches that one may add other oxidation bases.

Applicant's claimed second oxidation base is a laundry list of all or nearly all carboxylic and heterocyclic oxidation bases; it is not a teaching of the combination of the first particular oxidation base with a second particular oxidation base. Applicant argues that Tsujino does not teach applicant's first oxidation base. He need not because Henkel does, and Tsujino was not applied for the purpose of teaching said oxidation base. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments filed 7/31/2002 have been fully considered but they are not persuasive regarding the rejection of the claims under 35 USC 103(a) over Andrillon in view of Henkel. Again Applicant argues that there is no motivation to combine, when Andrillon teaches that mixtures of oxidation bases may be used, as does Andrillon. In this combination, both references provide the motivation to combine; Henkel giving the motivation for using the first claimed oxidation base and Andrillon giving the conventional practice of using more than one oxidation base in oxidative hair dyeing compositions and processes. Applicant further argues that the specification recites that the colorations provide by using 2,5-diaminophenoxyalkanes are not entirely satisfactory, and show insufficient resistance to various treatments to which hair may be subjected, and/or the action of light and that the addition of a second oxidation

Art Unit: 1751

base "surprisingly and unexpectedly" resulted in intense coloration. Applicant has presented no evidence to support the statements in the specification. The art clearly teaches the combination, and if indeed there are surprising and unexpected results from the combination, they must be presented.

Applicant next argues that Andrillon's teaching does not suggest the storage in conventional multicompartment devices and kits as claimed. In response to this argument, the examiner notes that for many years and in all salons, drug stores, department stores and any other place oxidation hair dyeing compositions are sold, they are encased in multicompartment kits, since they react immediately on mixing, and accordingly must be kept separate until immediately before use. Surely applicant is aware that this is so.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret Einsmann
Primary Examiner
Art Unit 1751

October 2, 2002